

Claim 65 has also been amended to more clearly recite that in addition to being "substituted by at least one atom of a radio-opacifying atom...", the X moiety may be further substituted.

The "X-L-S" diagram of claim 65 has been replaced by the characters "X-L-S".

Applicant believes that the amended claims comply with the Examiner's restriction requirement and also are consistent with the proposed amendment discussed in the interview with the Examiner on February 10, 2003. Hence, Applicant believes that the present pending claims should be allowed.

The Office Action included three obviousness-type double-patenting rejections. The second and third double-patenting rejections have been overcome by the submission of terminal disclaimers which accompany this response. The first double-patenting rejection was based on the parent patent (6,226,352). This present application is a divisional application from this parent patent. There was a restriction requirement from the Patent and Trademark Office in this parent patent, and this restriction requirement caused claims 65-79 to be canceled from the parent patent. These claims 65-79 are the subject of this divisional application. The patent statute at 35 U.S.C. §121 states that:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

This means that it is improper to use the parent patent, through any kind of double-patenting rejection, against this divisional application. Also see MPEP §804.01.

In view of this statute, Applicant respectfully submits that it is improper to require a terminal disclaimer between the parent patent (6,226,352) and its divisional application. Thus, Applicant submits that this first double-patenting rejection should be withdrawn.

Applicant respectfully submits that the foregoing amendments place the pending claims in condition for allowance.

#### **EXTENSION OF TIME**

Applicant hereby requests an extension of time to respond to the pending Office Action and a check for the extension fee is enclosed herewith. Please charge Deposit Account 02-2666 for any shortage in fees required by this response.

Respectfully submitted,

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#### **FIRST CLASS CERTIFICATE OF MAILING**

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February 25, 2003

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Connie Thayer

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Connie Thayer  
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2-25-03

Date

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

65. A composition having the general formula X-L-S wherein:

the S moiety is a pyranose [or a furanose];

the X moiety is an [unsubstituted or substituted] aryl, C<sub>1</sub>-C<sub>8</sub> alkyl, alkoxy, alkylthio, alkenyl, alkylaryl, alkylamino, alkylamido, amido, or arylamido, in which at least one atom is substituted by a radio-opacifying atom of an element with an atomic number of approximately Z = 35 to approximately Z = 74, and which may be further substituted; and

the L moiety is [an] unsubstituted or substituted, and is a C<sub>1</sub>-C<sub>8</sub> alkyl, alkoxy, alkylthio, alkenyl, alkylaryl, alkylamino, alkylamido, amido, or arylamido, and is bonded to the S moiety and to the X moiety.

76. A method of imaging tissue comprising:

a) administering a composition according to the formula of claim 65, [having a general formula S-L-X,] wherein said composition is cell membrane-permeable and wherein:

S is a binding moiety which selectively binds to a cellular molecule in said tissue;

X is a radio-opaque moiety; and

L is a linking moiety which links the S moiety to the X moiety;

b) irradiating said tissue with a radiation source which is capable of being attenuated by the X moiety; and

c) acquiring an image of said tissue.